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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/903,771

07/13/2001

Bettina Moeckel

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01/16/2004

EXAMINER

KERR, KATHLEEN M

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
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ALEXANDRIA, VA 22314

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,771

Applicant(s)

MOECKEL ET AL.

Examiner

Kathleen M Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-19,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4,12,14,16,18 and 37 is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 1,5,13,15,17,19 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Application Status***

1. In response to the previous Office action, a non-Final rejection (mailed on July 21, 2003), Applicants filed a response and amendment received on October 21, 2003. Said amendment cancelled Claims 6-8 and amended Claims 4, 5, and 10. Thus, Claims 1, 3-5, 10-19 and 37-38 are pending in the instant Office action and will be examined herein.

### ***Priority***

2. As previously noted, the instant application is granted the benefit of priority for the foreign application 10039043.9 filed in Germany on August 10, 2000; a translation of said document has been filed.

### ***Withdrawn - Objections to the Specification***

3. Previous objection to the specification for containing a sequence in the sequence listing that is not mentioned in the specification, that is SEQ ID NO:3, is withdrawn by virtue of Applicants noting to the Examiner where, in the specification, a description of SEQ ID NO:3 can be found.

### ***Withdrawn - Claim Objections***

4. Previous objection to Claims 4, 8, 10, and 11 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is withdrawn by virtue of Applicants' amendment.

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5. Previous objection to Claims 1, 3, 12-19, 37, and 38 as depending from rejected claims is withdrawn by virtue of Applicants' amendment.

***Withdrawn - Claim Rejections - 35 U.S.C. § 112***

6. Previous rejection of Claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for the washing conditions for stringent hybridization, is withdrawn by virtue of Applicants' cancellation of said claims.

7. Previous rejection of Claims 5-8, 10, and 11 under 35 U.S.C. § 112, second paragraph, as being indefinite for the "wherein" clause is withdrawn by virtue of Applicants' amendment.

8. Previous rejection of Claims 5-8 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicants' amendment.

9. Previous rejection of Claims 10 and 11 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicants' amendment.

10. Previous rejection of Claims 5-8 and 10-11 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicants' amendment.

***Withdrawn - Claim Rejections - 35 U.S.C. § 102***

11. Previous rejection of Claims 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Schmitt is withdrawn by virtue of Applicants' amendment.

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12. Previous rejection of Claim 8 under 35 U.S.C. § 102(a) as being anticipated by Pompejus *et al.* (WO 01/00842) is withdrawn by virtue of Applicant's cancellation of said claim.

13. Previous rejection of Claim 8 under 35 U.S.C. § 102(a) as being anticipated by Nakagawa *et al.* (EP 1108790) is withdrawn by virtue of Applicant's cancellation of said claim.

## NEW ISSUES

### *Claim Objections*

14. Claims 1 and 5 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, Claim 3. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 is the ultimate base claim of Claims 1 and 5. Claim 3 is drawn to a polynucleotide comprising SEQ ID NO:1; the specification describes SEQ ID NO:1 as encoding SEQ ID NO:2 and SEQ ID NO:2 is described as having LuxR transcriptional activation activity. Thus, the features of both Claims 1 and 5 are inherent in Claim 3, thus, these features cannot effectively further limit Claim 3.

### *Claim Rejections - 35 U.S.C. § 112*

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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15. Claims 10-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 10, the phrase "30 consecutive nucleotides of an isolated polynucleotide comprising SEQ ID NO:1" is confusing as it follows closed language ("consisting of"). "Comprising" in the noted phrase opens the scope of the 30 consecutive nucleotides to virtually anything. For example, if SEQ ID NO:1 is in a vector, that vector is an isolated polynucleotide comprising SEQ ID NO:1 and any 30 consecutive nucleotides, even those not within SEQ ID NO:1, are within the scope of the claim. This does not appear to be the intended scope of the claim since the specification describes such 30-mers as probes and/or primers for SEQ ID NO:1 and similar sequences.

Also, in Claim 11, the word "comprises" again opens the claim language inappropriately from the closed language of Claim 10 in the transitional phrase. Clarification is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

16. Applicant is advised that should Claims 12, 14, 16, 18, and 37 be found allowable, Claims 13, 15, 17, and 19 and 38 will be objected to under 37 C.F.R. § 1.75 as being a

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substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See M.P.E.P. § 706.03(k). This warning is due to the equivalence of Claims 1, 3, and 5 (all the same scope – see also objection above for not further limiting the claimed subject matter).

#### *Other Art of Record*

17. The Examiner cites the following:

- a) USPAP 2002/0197605 is a U.S. filing of Nakagawa *et al.* (EP 1108790) with a filing date of December 18, 2000, which date does **not** pre-date the effective filing date of the pending claims of the instant application thanks to their foreign priority support.

#### *Summary of Pending Issues*

18. The following is a summary of the issues pending in the instant application:

- a) Claims 1 and 5 stand objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, Claim 3.
- b) Claims 10-11 stand rejected under 35 U.S.C. § 112, second paragraph.
- c) A duplicate claim warning of Claims 13, 15, 17, and 19 and 38 if Claims 12, 14, 16, 18, and 37 were to be found allowable has been issued.

***Conclusion***

19. Claims 3, 4, 12, 14, 16, 18, and 37 are allowed. Claims 1 and 5 are objected to. Claims 13, 15, 17, and 19 and 38 are considered to be duplicate claims and not allowable over Claims 12, 14, 16, 18, and 37. Claims 10-11 are rejected for the reasons identified in the numbered sections of this Office action. Applicants must respond to the objections/rejections in each of the numbered sections in this Office action to be fully responsive in prosecution.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.



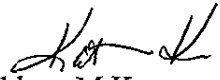
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Kathleen M Kerr  
Examiner  
Art Unit 1652

January 8, 2004



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